Remarks/Arguments

The Official Action rejected the pending claims under 35 U.S.C. 103(a) as being unpatentable over Taylor, US 5,899,981 in view of PR Newswire Article.

Each of the independent claims requires a server that monitors employee manager performance in relation to approval of invoices/time entries. The combination of Taylor and the PR Newswire article fail to show this. More specifically, Taylor does not shown logic with a server that tracks employee manager performance and, more specifically, transmission and receipt times for a specified individual (here, the manager) for the purposes of determining whether to generate an award. The PR Newswire, which Applicants do not believe can properly be combined with Taylor absent a suggestion to combine the two, teaches incentives for travelers and not providing awards to employee managers for timely invoice/time entry approvals.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24

U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on applicant's disclosure. MPEP 2143, p. 2100-121 (August 2001).

As the combination of Taylor and PR Newswire are not believed proper based upon a lack of a suggestion for combining the two, the Applicant believes the grounds of rejection are overcome. Nonetheless, the Applicants have amended the claims to clarify the invention. Further, even if the combination is proper, the Applicants do not believe that the required elements of the claims are shown by these two references.

Please direct any questions or comments to the undersigned attorney regarding the Notice of Allowance in this case.

Respectfully submitted,

Date: May 28, 2004 By:

James A. Harrison, Reg.40,401
Garlick Harrison & Markison, LLP
P.O. Box 670007
Dallas, Texas 75367
(214) 902-8100/office
(214) 902-8101/facsimile